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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,800	04/13/2004	Takashi Saito	D-1612	3067

7590

11/03/2005

HAUPTMAN KANESAKA BERNER PATENT AGENTS, LLP
Suite 310
1700 Diagonal Road
Alexandria, VA 22314

EXAMINER

BEATTY, ROBERT B

ART UNIT	PAPER NUMBER
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2852

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,800

Applicant(s)

SAITO, TAKASHI

Examiner

Robert Beatty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The disclosure is objected to because of the following informalities: on page 3, line 28, change "above" to --below--.

Appropriate correction is required.

3. Claims 2, 5-7 are objected to because of the following informalities:

in claim 2, line 4, change "in" to --relative to-- so as to make it clearer that the image reading unit is located upstream (toward the backside) relative to the discharge direction of the first and second discharge stackers;

in claim 5-7, it is believed the applicant is trying to claim the structure described on page 20, lines 26-29 and thus it is recommended the applicant change the following:

in claim 5, line 3, delete "the image reading unit" and insert --on the image forming unit-- after "sheet finishing unit";

in claim 6, line 2, delete "side" and on line 3, change "in" to --relative to--;

in claim 7, line 2, change "mounting member" to --supporting portion--.

Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3,5,8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Mui et al. (U.S. 6,851,668).

Mui et al. teach an image forming apparatus comprising (see Fig.2) an image forming unit 22 for forming an image on a sheet and discharging the sheet to a first discharge stacker 26, a sheet finishing unit 28 such as a stapler, arranged above the image forming unit for performing a finishing operation on sheets and discharging the sheets to a second discharge stacker 32, and an image reading unit 52 for transporting and scanning an original, the reading unit positioned above the sheet finishing unit toward a backside of the apparatus relative to the sheet discharge direction and wherein the reading unit scans originals in a direction perpendicular to the discharge direction. Each of the image forming unit, finishing unit, and reading unit have their own frames (casings). The sheet finishing unit is mounted by some type of mounting device to the image forming unit.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mui et al. (U.S. 6,851,668) in view of Isobe et al. (U.S. 2003/0044209).

Mui et al. taught supra discloses most of what is claimed except the finishing unit has a finisher (e.g. stapler) on either the left or right side and on the other side is a drive means. Isobe et al. teach a finishing device 300 located above an image forming unit 100 and its discharge stacker 125, wherein the finisher has a stapler H on the right side and a drive means (rollers 320, 330 or movable aligning plate 302) on the left side (and right side). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the finishing unit in the arrangement as taught in Isobe et al. because sheets can be stapled and conveyed into the discharge tray in a stable manner.

6. Claims 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Isobe et al. '415, Koshimizu et al., Kato et al., Oshida, and Mui et al. '395 all teach various arrangements of image forming units, finishing units and reading units.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Beatty whose telephone number is (571) 272-2130. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley, can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Robert Beatty". The signature is fluid and cursive, with a long horizontal stroke at the end.

Robert Beatty
Primary Examiner
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October 29, 2005